

Appln. No. 09/586,964
Amdt. dated May 13, 2004
Reply to Office Action of February 25, 2004

REMARKS

Applicants request reconsideration and allowance.

Applicants respectfully request the Examiner to enter the amended claim and new claims. Amended claim 7 deletes a superfluous "." Amended claim 15 updates the claim dependency. New claims 26 et seq. find support in the original specification throughout. Attention is, however, respectfully directed to page 4; page 6; fourth paragraph; and the Examples. Attention is also invited to page 8, line 1 (sorbitol/erythritol 60/40) and, page 9 (Table 2, "S/E 60/40" and "S/E 80/20"). The range in new claims 36-38 finds support from the original specification including the Examples. Ex parte Jackson, 110 USPQ (BNA) 561, 562 (PTO Bd. App. 1956) (applicant can use examples to set up a range).

Applicants' representative acknowledges a telephone message left for the Examiner on May 11, 2004 and the Examiner's courtesy in responding on May 12, 2004. The applicability of 102(e) and 103(c) was discussed and it was suggested that the PTO's own interpretation of Title 35 in the "Q&A" on its web site appears to conflict with the statutory interpretation advanced in the Office Action. The Examiner indicated that she would consult with a special program examiner and Applicants acknowledge her cooperation with appreciation.

In the above regards, Applicants respectfully request the Examiner to reconsider the interpretation of the AIPA advanced in the Office Action, page 2. It is respectfully submitted that the Rosenplanter U.S. Patent reference should be reconsidered and withdrawn too as the commonly assigned U.S. Patent reference does not seem to be prior art. As to this application having been filed on June 5, 2000, and being commonly assigned with the cited Rosenplanter U.S. Patent, the US PTO's public position on its web site is:

D3. I have a patent application that was filed prior to November 29, 2000 (or claims benefit or priority to an application filed prior to November 29, 2000). Does the revised 35 U.S.C. 102(e) apply to this patent application? (Posted 12/13/02)

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1. Yes. 35 U.S.C. 102(e), as amended by the Technical Amendments Act, must be applied to **all patent applications no matter when filed**. In other words, the revised statute applies to patent applications filed **prior** to the effective date of November 29, 2000 as well as to patent applications filed on or after November 29, 2000. Additionally, the revised 35 U.S.C. 102(e) applies to **all** patents under reexamination or other proceedings challenging the patent. One of the reasons for the Technical Amendments Act was to provide for application of the revised statute to all patent applications, regardless of the filing date, and all patents.

(emphasis in original). Amended 103(c) "is effective for applications filed on or after November 29, 1999" as seen from the PTO's public position on its web site:

E3. What applications qualify for the prior art exclusion of 35 U.S.C. 103(c), as amended by the AIPA, of commonly owned or assigned prior art? (Posted on 12/6/01; updated 8/01/02)

1. The amendment to 35 U.S.C. 103(c) made by the AIPA is effective for applications filed on or after November 29, 1999. For the National Stage (35 U.S.C. 371) of International Applications, the international filing date must be on or after November 29, 1999 in order for applicant to invoke the exclusion of prior art under 35 U.S.C. 103(c) as amended by the AIPA. The date the applicant fulfilled the requirements of 35 U.S.C. 371(c)(1), (2) and (4) is not relevant in determining whether the application is entitled to the prior art exclusion under 35 U.S.C. 103(c) as amended by the AIPA. If a continuing application is filed after November 29, 1999, and claims the benefit of the prior international application filed prior to November 29, 1999, such continuing application would be entitled to revised exclusion provided in 35 USC 103(c). See "Guidelines Concerning the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors Protection Act of 1999," Notice, 1233 OG 54 (April 11, 2000) and "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 USC 103(c)," Notice, 1241 OG 96 (Dec. 26, 2000).

(Emphasis added). A request for publication does not appear to be mentioned as pre-requisite before the statutory provisions of 35 USC 103(c) apply to art cited under 35 USC 102(e).

It is respectfully submitted that forcing Applicants' to separately incur the time and expense of filing a request for publication, when the requirement alluded to in the Office Action does not seem to appear in either the statutory provisions in question or in the PTO's own published interpretations of same, ought to be reconsidered as well.

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If the Examiner has a contrary view, then it would be most helpful to be informed of the *current* statutory authority so that appropriate action can be expeditiously taken. *Please telephone the undersigned.*

Even if, *arguendo*, the Rosenplanter U.S. patent document was prior art, which it is not, the inventions claimed here are patentably different as seen from the prior traverse and declaration evidence of record. Furthermore, it is respectfully suggested that the specification provides additional objective evidence rebuttal evidence. For instance, Table 2 furnishes data for S/E of 60/40 and SE 80/20 and the range defined thereby that is recited in the claims. Other claims herein refer to S/E of 60/40 specifically. Still other claims refer to S/E of 80/20. All of these claims ought to be free from the rejection *even if* the Rosenplanter U.S. Patent is prior art. Accordingly, even if the Rosenplater U.S. patent document was prior art, the evidence of record rebuts the Examiner's thesis. It is furthermore respectfully, but earnestly, suggested that the Examiner's comments that product-by-process language are mis-directed since the product produced in the cited reference by its process is not the same as the product herein.

Applicants respectfully solicit a Notice of Allowance.

This Amendment, and the cover sheet(s) thereto, were filed by facsimile with the U.S. Patent Office on May 17, 2004 to facsimile number 703-872-9306.

Respectfully submitted,

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